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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,941	01/21/2004	Michael H. Bunyan	2802-257-088	4391

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John A. Molnar, Jr.
PARKER-HANNIFIN CORPORATION
6035 Parkland Boulevard
Cleveland, OH 44124-4141

EXAMINER

ALEXANDER, MICHAEL P

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 03/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/761,941	Applicant(s) BUNYAN ET AL.	
	Examiner Michael P. Alexander	Art Unit 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 1-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-36 and 38-47 is/are rejected.
- 7) ☒ Claim(s) 37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>August 29, 2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim(s) 1-47 is/are pending.

Election/Restrictions

Claims 1-31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9 February 2006.

Claim Rejections - 35 USC § 112

The rejections of claims 32-46 are withdrawn in light of the amendment filed on 9 February 2006.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 32-36, 38-41 and 46-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Chen et al. (US 2002/0119286 A1), on the same grounds as stated in the Office Action of 9 August 2005.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. as applied to claim 33 above, and further in view of Reinhardt et al. (US 5,578,362).

Claims 42-45 are rejected on the same grounds as stated in the Office Action of 9 August 2005. With respect to the amended limitation that the domains would be solid, the Examiner notes that Reinhardt teaches (see col. 6 lines 19-23) that the domains may be hollow, which by inference teaches that the domains may also be non-hollow. Furthermore, since the domains of Reinhardt are clearly not gas or liquid, then the domains would inherently be solid.

Claims 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. as applied to claim 33 above, and further in view of Kramer (US 2003/0045210).

Regarding claim 42, Chen et al. do not specify a resin filler forming a second solid phase within the continuous phase, the second phase being free of electrically conductive filler component. However, Kramer teaches (0007-0011, 0031) that a non-porous polishing pad can be improved by providing it with a plurality of continuously

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porous sections separated by solid polymer resin filled pores in order to retain the hydrodynamic lift associated with non-porous pads but with the enhance performance of continuously porous pads. It would have been obvious to one of ordinary skill in the art to modify the polishing pad of Chen et al. by providing it with a plurality of continuously porous sections separated by solid polymer resin filled pores in order to retain the hydrodynamic lift associated with non-porous pads but with the enhance performance of continuously porous pads as taught by Kramer.

Regarding claim 43, Kramer teaches (0031) that the purpose of the resin filler component is as a filler to separate the continuously porous sections. Since the amount of resin filler is a result effective variable as taught by Kramer, then it would have been obvious to one of ordinary skill in the art to select the desired amount of resin filler as a routine optimization in order to separate the continuously porous sections as taught by Kramer. See MPEP 2144.05 II.

Response to Arguments

Applicant's arguments, see page 10 paragraphs 3-6, filed 9 February 2006, with respect to claim 37 have been fully considered and are persuasive. The rejection of claim 37 has been withdrawn.

Applicant's arguments filed 9 February 2006 with respect to claims 32-36, 38-41 and 46-47 have been fully considered but they are not persuasive.

First, applicant seems to be admitting by inference (see page 9 paragraph 8) that the carbon powder of Chen would inherently have the claimed functional properties.

Second, applicant cites *In re Jones* as authority for the proposition that a claimed species is not rendered prima facie obvious solely by the disclosure of an encompassing prior art genus. After reading *In re Jones*, the Examiner asserts that the instant case is different. The reference in *In re Jones* merely disclosed a genus and did not list any species which would anticipate the claimed invention. However, in the instant case, the Chen et al. discloses a list of species, at least one of which would anticipate the claimed invention.

Third, applicant argues that Fig. 4 of the present application shows that not all metal filled compounds fall with the claimed species of compounds exhibit a relatively high overpotential. In response, the Examiner notes that the claims are directed to compounds exhibiting an overpotential, not to compounds exhibiting a "relatively high overpotential".

Fourth, applicant argues that Chen et al. is silent as to the effect of overpotential. In response, see MPEP 2112 I, which states that something which is old does not become patentable upon the discovery of a new property.

Allowable Subject Matter

Claim 37 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Alexander whose telephone number is 571-272-8558. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy V. King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mpa

ROY KING
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700